

**REMARKS/ARGUMENTS**

Claims 1-32 are pending in the application. By this Amendment, claims 27-32 are added to the application. Support for the new claims can be found throughout the original specification and drawings. In view of the foregoing amendments and the following remarks, reconsideration and withdrawal of the rejections is respectfully requested.

**CLAIMS 21-26 RECITE ALLOWABLE SUBJECT MATTER**

The Office Action rejects claims 21-26 under 35 U.S.C. §101 because the claims are allegedly directed to non-statutory subject matter. The rejection is respectfully traversed. The comments in the Office Action indicate that these claims define both tangible embodiments, and intangible embodiments. Specifically, the comments indicate that the tangible embodiments are directed to a "computer medium" and that the intangible embodiments are directed to a "readable medium." Because the quoted language does not conform to the language in the claims, these comments are not understood.

Claim 21 clearly recites, in its preamble, "a computer readable medium that includes software configured to cause a computer to perform the steps of:" Thus, claim 21 is clearly directed to a computer readable medium, such as disk or CD, which contains software with instructions which are to be executed by the processor of a computer. As such, it is respectfully submitted that claim 21 is directed to a tangible embodiment. It is further respectfully submitted that claim 21 is not directed to an intangible embodiment, as asserted in the Office Action. For at least these reasons, withdrawal of the rejection under §101 is respectfully requested.

**CLAIMS 6-10 ARE ALLOWABLE OVER JORGENSEN**

The Office Action rejects claims 6-10 under 35 U.S.C. §102(b) over U.S. Patent No. 5,990,874 to Jorgenson. Because Jorgenson fails to disclose or suggest all the features of these claims, the rejection is respectfully traversed.

Jorgenson discloses a system and method for controlling one or more pointing devices which are connected to a computer. As shown in Figure 2, the system includes a keyboard 17 and a pointing device 24 which are both coupled to a keyboard controller 18, as is common practice in the art. The controller 18 then communicates with the BIOS 20 of a computer. The BIOS 20 is coupled to a look-up table 22, which is used to interpret various commands which are input through the keyboard 17.

Jorgenson discloses that by hitting one or more keys on the keyboard 17, a user can instruct the computer to either disable or enable the pointing device 24. Specifically, Jorgenson indicates when the key sequence for deactivating the pointing device has been pressed by a user, the signals from the keyboard 17 are forwarded by the controller 18 to the BIOS 20. The BIOS 20 consults the look-up table to determine the meaning of the key sequence pressed by the user. In this instance, the BIOS would determine that the key sequence is an indication by the user to deactivate the pointing device 24. The BIOS 20 would then send a signal to the controller 18 instructing the controller to ignore any further data it receives from the pointing device 24. Acting on this command, the controller 18 would then block any data from the pointing device 24 from reaching the BIOS 20.

In alternate embodiments, as shown in Figure 3, multiple pointing devices can be connected to the keyboard controller 18. In this embodiment, the user can hit keys on the

keyboard 17 to instruct the computer to enable or disable one or more of the two pointing devices. Here again, the BIOS would be instructing the controller 18 to either accept and forward data from one of the pointing devices, or ignore data input through the pointing devices so that they will not reach the BIOS. In other words, when one of the two pointing devices is to be blocked, the controller will ignore any data received from that pointing device, and the controller will not forward the data onto the BIOS 20.

Claim 6 of the present application recites a computer system which includes an internal input device configured to receive user commands, and a controller coupled to the internal input device and communicating with an operating system program. Claim 6 recites that the operating system program is configured to receive an “enable function key input” indicating that an external input device should be enabled. Claim 6 further recites that the operating system is configured to ignore data from the internal input device and to receive data from the external input device and when the enable function key input is received. Thus, claim 6 recites that the operating system itself would receive data from the internal input device, but would ignore that data after the enable function key input is received.

These differences between the system recited in claim 6 and the system and method disclosed in Jorgenson result from real-world differences in how the associated hardware is configured. As explained in the specification of the present application, in a system as recited in claim 6, an external input device such as a USB mouse is connected to the computer system via a universal serial bus (USB) data port. As shown in Figure 2 of the present application, when a USB mouse (or similar device) is connected to the computer in this fashion, the mouse would be able to directly communicate with the operating system, and with the BIOS resident on the

computer. The data from the external USB mouse would not be forwarded through or controlled by a separate keyboard controller which would then forward the data on to the operating system or BIOS. Of course, the use of the universal serial bus is just one example of how such a system could be arranged. In other systems embodying the invention, a different type of bus or connection could be made between the external input device and the operating system or BIOS.

In contrast, in the Jorgenson system both the keyboard and all of the pointing devices are coupled to a keyboard controller. The keyboard controller receives data from the various devices, and then selectively forwards the data on to the BIOS. As explained above, this means that in the Jorgenson system, the keyboard controller can be instructed to ignore data from one or more of the pointing devices, to effectively disable the devices.

As explained above, claim 6 specifically recites that the operating system is configured to receive an “enable function key input” indicating that an external input device should be enabled. The operating system would then receive data from the external input device. However, claim 6 also recites that the operating system is configured to ignore data from the internal input device after the “enable function key input” is received. This means that the keyboard controller would continue to forward data from the internal input device to the operating system, but that the operating system would ignore this data. This is distinctly different from the system and method disclosed in Jorgenson, wherein the keyboard controller itself block data from the input device from reaching the BIOS. For all the above reasons, it is respectfully submitted that claim 6 is allowable over Jorgenson.

Claims 7-10 depend from claim 6 and recite additional features which are also not shown or suggested by Jorgenson. For instance, claim 8 recites that the external input device comprises a USB mouse. The fact that Figure 3 of Jorgenson shows that all pointing devices are connected through a keyboard controller clearly indicates that Jorgenson does not contemplate the use of a USB mouse, which would instead send data directly to the BIOS. In addition, claim 10 recites that the operating system is configured to update a system BIOS memory to indicate that an external input device has been attached when the enable function key is received, and that the operating system is also configured to update a system BIOS memory to indicate that an external input device has been detached when the disable function key is received. Jorgenson also fails to disclose or suggest these features of claim 10.

In view of all the foregoing, withdrawal of the rejection of claims 6-10 over Jorgenson is respectfully requested.

**CLAIMS 1-5 AND 11-26 ARE ALLOWABLE OVER DENG AND WATTS**

The Office Action rejects claims 1-5 and 11-26 under 35 U.S.C. §103(a) over Deng (U.S. Patent No. 6,829,672), in view of Watts (U.S. Patent No. 6,341,320). Because the references are not combinable, and because even the improper combination of the references fails to disclose or suggest all the features of these claims, the rejection is respectfully traversed.

Deng discloses an electronic flash memory storage device which is intended to be connected to a USB data port of a computer. Deng indicates that when the external data storage device is connected, the computer automatically recognizes the device and is ready to read data from or write data to the external storage device.

Watts discloses a computer docking station which can be used connect a laptop computer to a full-sized keyboard and monitor. The disclosure of Watts is primarily directed to the docking station itself, and not to a laptop computer which is to be inserted into the docking station. However, at column 31, lines 61-64, Watts indicates that when an external keyboard is attached, the system (the laptop computer) automatically disables the laptop computer's internal keyboard. This passage goes on to state that if no (external) keyboard is attached, the system automatically enables the laptop computer's internal keyboard. There is no disclosure about how this disabling and enabling of the laptop computer's keyboard is to be carried out.

The Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify the Deng system, based on the teachings of Watts, to arrive at a system, as recited in claims 1-5 and 11-26. More specifically, it appears that the Office Action in asserting that one of ordinary skill in the art would use the teachings in Watts about disabling an internal device when an external device is attached to modify the Deng system. Presumably, this would mean modifying the Deng system so that when an external storage device is attached to the Deng system via a USB port, the Deng system would disable a corresponding internal device. Because the Deng system is directed to an external storage device, then if one were to apply the teachings of Watts to the Deng system, the result would be a computer system that disables one of its internal storage devices when an external storage device is attached to a USB port on the computer.

The external storage device in the Deng system is intended to act as a supplementary data storage device data, and/or to facilitate the transfer of data from one computer system to another. Thus, in the Deng system, when a user connects the external storage device to a

computer, one would expect the user to then access the data stored on the external storage device. If the user was using the external storage device to transfer data from another computer, the user would cause the computer to copy data from the external storage device to an internal storage device, such as a hard drive. Even if the user was not copying data from the external storage device, the user would want to be able to continue to have access to the computer's internal disk drives. For all these reasons, it is respectfully submitted that one of ordinary skill in the art would not modify the Deng system such that when an external storage device is coupled to a USB port of the system, one of the system's internal storage devices is disabled.

Because one of skill in the art would not have motivated to use the teachings of Watts to modify the Deng system, it is respectfully submitted that the combination is improper. For at least these reasons, withdrawal of the rejection is respectfully requested.

**A. Claims 1-5**

In addition, even the improper combination of Deng and Watts fails to disclose or suggest all the features of the rejected claims. For instance, claim 1 recites an internal input device and a controller coupled to the internal input device and communicating with the operating system program. Claim 1 recites that the operating system program determines when an external USB input device is attached to the computer, and that the operating system is configured to ignore data from the internal input device and to receive data from the external USB input device when an external USB input device is attached to the computer system.

As explained above, Watts is directed to a docking system which can allow an external keyboard to be attached to a notebook computer. It is clear from the disclosure of Watts that the external keyboard is not a USB input device. The relevant disclosure in Watts, at column 31,

lines 58-60 clearly indicates that the keyboard cable connector is one of the circular five pin connectors. Data from this type of keyboard would be routed to a keyboard controller, which would then forward the data on to the system BIOS or operating system. This type of keyboard is not the kind that would be coupled to a universal serial bus that sends data directly to the BIOS. In this respect, the Watts system is similar to the Jorgenson system discussed above. Thus, the external keyboard disclosed in Watts is not a USB input device.

As also noted above, Deng makes no reference whatsoever to an external USB input device such as a pointer or a mouse. Instead, Deng merely discloses connecting an external data storage device to a USB port.

For all the above reasons, it is respectfully submitted that claim 1 is allowable over even the improper combination of Deng and Watts.

Claims 2-5 depend from claim 1 and are allowable at least for the reasons discussed above. In addition, the dependent claims recite additional features which are also not shown or suggested by Deng and Watts. For instance, claim 3 recites that the external USB input device is a USB mouse. Claim 5 recites that the operating system is configured to update a system BIOS memory to indicate that an external USB device has been attached when the attachment of an external USB input device is detected. Claim 5 further recites that the operating system is also configured to update a system BIOS memory to indicate that an external USB input device has been detached when the detachment of an external USB device is detected. It is respectfully submitted that the dependent claims are also allowable for these additional reasons.



**B. Claims 11-19**

Claim 11 is directed to a method for controlling a computer. Claim 11 recites determining whether an external USB input device has been attached to the computer, and disabling an internal input device in the computer and enabling the external USB input device when the result of the determining step indicates that an external USB input device has been attached to the computer.

As noted above, Deng fails to disclose or suggest disabling an internal input device when an external USB input device is attached. Watts fails to disclose any type of external input device which a USB input device. Accordingly, it is respectfully submitted that claim 11 is also allowable over Deng and Watts.

Claims 12-19 depend from claim 11 and are allowable for at least the reasons discussed above. In addition, the dependent claims recite additional features which are also not shown or suggested by Deng or Watts. For instance, claim 12 recites that the method comprises updating a system BIOS. Claim 14 recites that the determining step comprises receiving an enable function key input. Claim 17 recites that the step of determining when the external USB input device has been detached from the computer comprises receiving a disable function key input. Claim 18 recites a step of updating a system BIOS. Claim 19 recites that the method further comprises exchanging periodic messages between a controller and the internal input device after the internal input device has been disabled, such that it is not necessary to re-initialize the internal input device in order to re-enable the internal input device. Deng and Watts fail to disclose or suggest all these additional features recited in the dependent claims. It is respectfully submitted that the dependent claims are also allowable for these additional reasons.

**C. Claim 20**

Claim 20 recites means for determining whether an external USB input device has been attached to the computer, and means for disabling an internal input device of the computer and enabling the external USB input device when the determining step indicates that an external USB input device has been attached. For all the reasons discussed above, it is respectfully submitted that claim 20 is also allowable over Deng and Watts.

**D. Claims 21-26**

Claim 21 is directed to a computer readable medium that includes software which is configured to cause a computer to perform the steps of determining whether an external USB input device has been attached to the computer, and disabling an internal input device of the computer and enabling the external USB input device when the determining step indicates that the external USB input device has been attached. For all the reasons discussed above, it is respectfully submitted that claim 21 is also allowable over Deng and Watts. Claims 22-26 depend from claim 21 and are allowable for the same reasons, and for the additional features that they recite.

In view of all the foregoing, withdrawal of the rejection of claims 1-5 and 11-26 is respectfully requested.

**NEW CLAIMS 27-32**

By this Amendment, claims 27-32 are added to the application. Claims 27-32 depend from various ones of the above-discussed independent claims and recite additional features

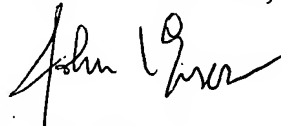
which are also not shown or suggested by the references of record. Accordingly, it is respectfully submitted that claims 27-32 are also allowable.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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